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In re Application of	:	
BAKER, et al.	:	
Application No.: 10/526,942	:	
PCT No.: PCT/US04/40409	:	DECISION ON PETITION
Int. Filing Date: 02 December 2004	:	UNDER 37 CFR 1.47(a)
Priority Date: 12 December 2003	:	
Attorney Docket No.: 718452.9	:	
For: URINARY TRANSFER SYSTEM AND	:	
ASSOCIATED METHOD OF USE	:	

This decision is in response to applicants' "Renewed Petition under 37 C.F.R. Section 1.47(b)" filed 12 January 2006. Additionally, the declaration submitted on 12 January 2006 will be considered pursuant to 37 CFR 1.42.

Applicants' previous petition under 37 CFR 1.47(b) was dismissed because the petitioner did not provide a declaration in compliance with 37 CFR 1.47(a)-(b). Since the filing of the petition under 37 CFR 1.47(b), the representative of the deceased inventor has executed the declaration and the response to the Decision submitted 12 January 2006 will be treated as a petition under 37 CFR 1.47(a).

BACKGROUND

On 02 December 2004, applicants filed international application PCT/US04/40409, which claimed a priority date of 12 December 2003. The international application listed Warren Spielman as an applicant/inventor and Larry R. Baker as a deceased inventor. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 07 July 2005. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States is to expire 30 months from the priority date, 12 June 2006.

On 08 March 2005, applicants filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and a preliminary amendment.

On 16 September 2005, applicants filed a "Petition under 37 C.F.R. Section 1.47(b) by Entity Having Proprietary Interest to File Application on Behalf of Inventor Who Refuses to Sign Declaration."

On 25 October 2005, applicants filed "Letter for Express Request to Begin National Phase Proceedings."

In a "Decision on Petition" dated 13 December 2005, applicants' petition under 37 CFR 1.47(b) was dismissed without prejudice.

On 12 January 2006, applicants filed "Renewed Petition under 37 CFR Section 1.47(b)" which is being treated as a Petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. The 37 CFR 1.47(a) applicant has satisfied the requirements of items (1); (2); and (3). However, item (4) has not been satisfied.

Regarding item (4) above, an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor has been submitted with the present petition, however, the declaration is not in compliance with 37 CFR 1.42 and 1.497(b)(2).

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Section 409.01(a) of the Manual of Patent Examining Procedure (MPEP) states that the application can also be executed by "all of the heirs" of the deceased inventor, where no legal representative has been appointed.

The declaration filed 12 January 2006 is executed by the personal representative (James D. Baker) on behalf of deceased inventor, Larry R. Baker. However, the declaration does not state that James D. Baker is the "legal" representatives or are all of the heirs of the deceased inventor. Further, the declaration does not satisfy the requirements under 37 CFR 1.497(b)(2).

37 CFR 1.497(b)(2) states the following:

(2) If the person making the oath or declaration or any supplemental

oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to revised 37 CFR 1.497(b)(2), in addition to the citizenship and former residence and post office address of the deceased inventor referenced under 37 CFR 1.497(a)(3) and 37 CFR 1.63, the declaration must also provide name, residence, citizenship, and post office address for the legal representative. The declaration filed on 12 January 2006 does not include the last known post office address for the deceased inventor. Additionally, the declaration does not name the person executing the declaration on behalf of the deceased inventor. Accordingly, the declaration is not in compliance with 37 CFR 1.497(b)(2).

For the reasons stated above, it would not be appropriate to accept the application without the signature of Warren Spielman under 37 CFR 1.47(a) at this time.

CONCLUSION

The petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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